

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

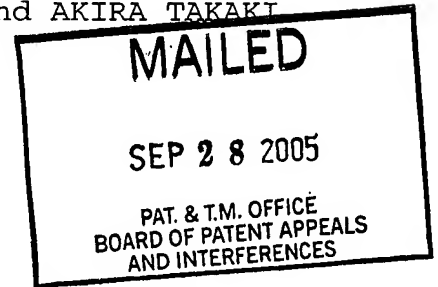
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte NORIKO SAKASHITA, YASUHIRO MIKI and AKIRA TAKAKI

Appeal No. 2005-1464  
Application No. 10/730,887

HEARD: August 10, 2005



Before WALTZ, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

**REMAND TO THE EXAMINER**

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner, via the Office of Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

We first provide a somewhat extensive summary of the prosecution history of this case, which is set forth below.

Claims 1-4 stand rejected under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103(a) over Tuzuki. Claims 1-4 stand rejected under 35 U.S.C. § 102(b), or alternatively, under 35 U.S.C. § 103(a) as being unpatentable over Matsuba '420.<sup>1</sup>

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<sup>1</sup> We note that this patent has a European Patent Application counterpart, EP 392465. We note that the examiner also rejected claims 1-4 under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over this European counterpart.

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a) over British Patent 1,378,434.

A copy of claim 1 is set forth below, wherein the text in bold is for emphasis only:

1. A **processing aid for a vinyl chloride resin having specific viscosity  $\eta_{sp}$  of at least 0.5**, which is obtained by polymerizing

1 to 50 parts by weight of a monomer mixture (B) comprising 0 to 49% by weight of methyl methacrylate,

51 to 100% by weight of at least one monomer selected from the group consisting of a methacrylate ester except methyl methacrylate and an acrylate ester, and

0 to 20% by weight of a vinyl monomer copolymerizable therewith, **in the presence of a latex of a copolymer having specific viscosity of at least  $\eta_{sp}$  0.7**, which is obtained by polymerizing in emulsion 99 to 50 parts by weight of a monomer mixture (A) comprising

51 to 100% by weight of methyl methacrylate,

0 to 49% by weight of at least one monomer selected from the group consisting of a methacrylate ester except methyl methacrylate and an acrylate ester, and

0 to 20% by weight of vinyl monomer copolymerizable therewith, wherein the total amount of (A) and (B) is 100 parts by weight,

**and wherein specific viscosity is measured at 30°C using Ubbelohde's Viscometer on 0.1 g of polymer dissolved in 100 mL chloroform.**

The examiner relies upon the following references as evidence of unpatentability:

Tuzuki et al. (Tuzuki)	4,179,481	Dec. 18, 1979
Matsuba et al. (Matsuba)	5,093,420	Mar. 3, 1992
Matsuba et al. (Matsuba)	EP 0 392 465	Oct. 17, 1990
British Patent	GB 1 378 434	Dec. 27, 1974

As indicated above, claim 1 recites two specific viscosity values. In lines 1-2 of claim 1, claim 1 recites that the processing aid (second step polymer) has a specific viscosity of at least 0.5. At line 8 of claim 1, claim 1 recites that the specific viscosity of the first step polymer is at least 0.7.

On pages 3-4 of the answer, the examiner finds that Tuzuki discloses that the second step polymer has a specific viscosity of at least 0.5. On pages 4-5 of the answer, the examiner finds that Matsuba teaches that the second step polymer has a specific viscosity of 1 or more. On pages 5-6 of the answer, the examiner finds that British Patent 1,378,434 teaches a second step polymer giving a specific viscosity of at least 0.5.<sup>2</sup>

Upon our review of claim 1, we observe that claim 1, last three lines, indicates that the specific viscosity is measured at 30°C using Ubbelohde's Viscometer on 0.1 g of polymer dissolved in 100 mL chloroform. Yet, each of the applied references

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<sup>2</sup> On page 6 of the answer, the examiner acknowledges that none of the applied references discuss the specific viscosity value of the first step polymer. The examiner states, however, that the specific viscosity of the first step polymer of each of the applied references would possess the claimed specific viscosity values in light of the fact that the composition and the preparation of the polymers are essentially the same. In this context, we refer to the examiner's finding made on pages 3-6 of the answer.

measures the viscosity in a benzene solution, and not in chloroform.

We also observe that in an Amendment after Final, filed on September 10, 2002 (in Parent Application 09/530,202), appellants filed a Declaration under 37 CFR § 1.132, dated March 19, 2002, that provides for a conversion equation for measuring specific viscosity in benzene versus in chloroform. On page 4 of that Amendment, appellants indicated that claim 1 was amended to include measurement of the specific viscosity based on chloroform. In addition to providing a conversion equation, the Declaration also provides for the value of the specific viscosity of Comparative Example 5 of Matsuba (U.S. Patent No. 5,093,420).<sup>3</sup> The Declaration indicates that the viscosity of the obtained polymer was measured by using chloroform, and that the obtained viscosity values of the first step polymer and the second step polymer are .64 and .58 respectively.<sup>4</sup> See the Declaration dated March 19, 2002, pages 3-4.<sup>5</sup>

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<sup>3</sup> With regard to Comparative Example 5 of Matsuba, it appears to us that this is not the closest example to appellants' claimed invention that is provided by Matsuba. We note that Comparative Example 5, as shown in Table 1 and columns 9 and 10 of Matsuba, is discussed in column 9, beginning at line 35. There, it is discussed that Comparative Example 5 contains samples (5) to (8) of the two-stage polymers which are prepared by using only methyl methacrylate as the component (A) instead of the monomer mixture (A) of methyl methacrylate and butyl methacrylate as in Examples 1 and 3. It appears that Examples 1 and 3 using component (A) of the monomer mixture of methyl methacrylate and butyl methacrylate are closer to appellants' claimed invention than is Comparative Example 5. It would be more helpful therefore to provide the converted specific viscosity values of Examples 1 and 3.

<sup>4</sup> We note also that a Response by appellants was filed on March 27, 2002 (also in parent application 09/530,208). On page 3 of that Response, Tuzuki is discussed, and specific viscosity values, as measured by chloroform, are provided. Likewise, Matsuba is discussed, and specific viscosities, by the chloroform method, are provided. These values were not discussed in the brief or in the answer.

<sup>5</sup> Another Declaration is discussed in appellants' brief, beginning on page 9 of the brief. This Declaration is dated March 6, 2003. This particular

In spite of the extensive prosecution history regarding converted viscosity values measured using chloroform, as described above, no discussion about this is presented in the answer or in the brief.

We therefore remand this application to the examiner so that the examiner can bring the above-mentioned issues properly before us for our consideration.<sup>6</sup> We authorize the examiner to reopen prosecution of the application in order to do so.

This remand is made pursuant to 37 CFR § 41.50(a)(1) and (2) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

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Declaration does not discuss the conversion equation regarding specific viscosity values based upon chloroform (although the specific viscosity values of .64 and .58 are repeated (comparative example 5 of Matsuba), but no other specific viscosity values are provided).

<sup>6</sup> We also hesitate to make our own fact findings at this point in time. See, In re Sujeet Kumar, 418 F.3d 1361, \_\_\_ USPQ2d \_\_\_ (Fed. Cir. 2005).

REMAND TO THE EXAMINER

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